

REMARKS

Status of Claims

Claims 1-13 are pending in this application. Claim 14 has been withdrawn from consideration by the Examiner. No claims are amended by this response.

Same-Invention Double Patenting Objection

The Examiner has objected to claims 1-5 under 37 C.F.R. 1.75 as being a substantial duplicate of claim 7, stating that "there is no patentable distinction seen between the compounds of claims 1-5 and the product produced by the process of claim 6." Office Action at 3. Applicants respectfully traverse this objection.

Indeed, Applicants have a "right to restate (i.e., by plural claiming) the invention in a reasonable number of ways." M.P.E.P. §706.03(k). "[A] mere difference in scope between claims has been held to be enough." *Id.* Furthermore, a difference in scope (i.e., distinct inventions) between product claims and product-by-process claims can be shown when "the product as *claimed* can be made by a materially different process." M.P.E.P. § 806.05(f). As the court has stated before, "[a] good test, probably the only objective test, for 'same invention,' is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention." *In re Vogel*, 422 F.2d 438, 441. (C.C.P.A. 1970).

In the instant application, the claims do not define the same invention because claims 1-5 may be infringed without infringing claim 7 if the product is produced via a different process. As one non-limiting example, "the cyclipostins according to the invention can be produced by *Actinomycetales* species, preferably by *Streptomyces* species HAG 004107, DSM 13381." Instant Specification at 13. Thus, the product-by-process claim 7 limits the invention to a compound produced by a specific species,

whereas the product claims 1-5 are wider in scope, as the compounds can be produced by other means, including but not limited to other *Actinomycetales* species. Therefore, Applicants respectfully request the withdrawal of this objection and allowance of the pending claims.

§ 103 Obviousness Rejection

The Examiner has rejected claims 1, 4, 5, 7, 10, 12 and 13 under 35 U.S.C. § 103(a) as obvious over Kurokawa et al. in view of Izawa et al. The Examiner alleges that Kurokawa teaches "cyclophostin (I) having activity against acetylcholinesterase and which differs from the instant compound when R1 is C2 and X1 is O, by being a next adjacent homolog." *Id.* Additionally, the Examiner relies on Izawa as showing that "methyl and propyl, or alkyl, can be interchanged on the same cyclophostin compound, albeit a different position, and the insecticidal activity be maintained." *Id.* Applicants respectfully traverse this rejection.

The Examiner has failed to establish a *prima facie* case of obviousness. In order to establish a *prima facie* case, an Examiner must point to, among other things, a suggestion or motivation to modify the reference or to combine reference teachings. M.P.E.P. §2142. The Examiner must set forth "clear and particular" evidence of such motivation, *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999), and such a showing must be by "substantial evidence." *In re Zurko*, 258 F.3d 1378, 1384 (Fed. Cir. 2001). The Examiner has failed to meet this high burden, and therefore Applicants respectfully request reconsideration of this application.

The Examiner has not established any motivation to combine or modify the reference teachings. The reference compounds and the present invention are

structurally different in the R¹ group, wherein Kurokawa and Izawa have a methoxy and the present invention can be, among other things, an ethoxy or other alkoxy group. To the unexpected surprise of the Applicants, this structural difference in the R¹ group results in profoundly new activity, namely lipase inhibition, as opposed to solely the insecticidal activity (acetylcholinesterase inhibition) of the reference compounds. As Applicants have disclosed in the instant specification, the reference cyclophostin of Kurokawa "has no selective lipase-inhibiting properties." Instant Specification at 3.

Even assuming, *arguendo*, that the Examiner has established a *prima facie* case of obviousness, such a case is rebutted on the ground that Applicants' invention exhibits unexpected results. This showing of unexpected results is sufficient to overcome any alleged obviousness.

Where two compounds are structurally similar, but the novel compound's activity is different from the prior art compound's activity, there is a sufficient showing of unexpected results so as to overcome an obviousness rejection. *See In re Papesch*, 315 F.2d 381 (C.C.P.A. 1963). In *Papesch*, the court held there was no obviousness where the claimed compound differed from the prior art only by the substitution of three ethyl groups for three methyl groups. *Id.* at 386-87. According to the court, the applicant's affidavit that the claimed compound produced an anti-inflammatory agent while the prior art compound did not showed an unexpected property that sufficiently overcame a *prima facie* case of obviousness. *Id.*

[T]he patentability of the thing does not depend on the similarity of its formula to that of another compound but of the similarity of the former compound to the latter. There is no basis in law for ignoring any property in making such a comparison. An assumed similarity based on a comparison

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of formulae must give way to evidence that the assumption
is erroneous.

Id. at 391.

Additionally, unexpected results carry even more weight in the chemical arts:
"The principle [that unexpected results can rebut a *prima facie* case of obviousness]
applies most often to the less predictable fields, such as chemistry, where minor
changes in a product or process may yield substantially different results." *In re Soni*, 54
F.3d 746, 750 (Fed. Cir. 1995). Thus, even if the Examiner has established a *prima
facie* case of obviousness, Applicants respectfully request the withdrawal of this
rejection based on the unexpected results of the claimed compounds.

Conclusion

In view of the foregoing remarks, Applicants respectfully request the
reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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